REMARKS

Although not entitled to consideration because prosecution is closed and the proposed amendment was not suggested in an explicit statement by the Broad, the applicants are nevertheless submitting for consideration under 312 amendment practice.

This application was involved in Patent Interference No. 105,262 which is now terminated. The Applicant herein (the Party Gugumus) was awarded priority on the sole count of the interference and the application will now be returned to *ex parte* prosecution before the examiner.

It is noted that following the decision by the Board of Patent Appeals and Interferences (July 27, 2006) an appeal was taken to the U.S. District Court for the District of Delaware. Such appeal was dismissed on November 19, 2008, and the Board's decision thus became final with respect to priority.

At this time, the Applicant wishes to add claims to the application to round out the protection which Applicant deems he is entitled. Thus, new claims 29-41 are presented.

The initial claim presented herein is claim 29. In respect to this claim, it is pointed out that during the course of Interference No. 105,262 an Amendment to this application was presented adding claim 28. A copy of that Amendment is attached hereto for the convenience of the Examiner. Claim 28 is based expressly on Example 1 of Applicant's European Application No. 95810042.2 filed January 23, 1995. See pages 25 and 26 of the verified English translation of the priority document which is of record in the USPTO in the file of Applicant's parent Application Serial No. 09/275,859 (submitted May 31, 2000). This claim defines the components of the stabilizer mixture by their structural formulas, such structural formulas having been established by evidence submitted in the interference.

The Board, in its decision, granted the motion of Gugumus to add claim 28 to the present application and priority of invention was granted to Gugumus based upon that claim.

Claim 29 is now being added to the application and differs from claim 28 in that it defines the components of the stabilizer mixture by the trademark names of the commercially available materials. Defining the components in this manner more strictly conforms the claim to the language of the example of Applicant's priority application. Furthermore, express basis is present in this application

for the preferred use of TINUVIN 622 ® as component a) and UVASORB HA88 ® as component e). See the specification page 9, the second paragraph. Also see Example 1 at pages 35 and 36.

It is recognized by Applicant that it is somewhat unusual for claims to contain reference to a component of a composition by its trademark designation. However, it is pointed out that the Manual of Patent Examining Procedure at MPEP 2173.05(U) states that "The presence of a trademark or trade name in a claim is not, *per se*, improper under 35 USC §112...". Furthermore, the Board, in the course of Interference No. 105,262, held that Example 1 of Applicant's EP priority document which specified the components of the stabilizer mixture by trademark designation complied with both the written description and enablement provisions of 35 USC §112. Claim 29 does nothing more than recite the substance of Example 1 in precisely the same language as the Example and is thus proper.

At the time of the declaration of Interference No. 105,262, the present application contained claims 16-27. During the interference, the Board held that these claims were unpatentable over the Raspanti U.S. Patent No. 5,658,973 at issue in the interference. The basis for that determination was that the Gugumus EP priority application did not support the full scope of claims 16-27 and thus Gugumus was not entitled to the benefit of the filing date of the priority application for those claims. The Raspanti patent was thus deemed an effective reference against those claims.

In order to avoid the rejection of claims 16-27, Applicant is presenting herewith new claims 30-41 which are fully supported by the EP priority application and thus not subject to rejection as being unpatentable over the Raspanti USP 5,658,973. No new matter is added.

In respect to the newly presented claims, it is noted that the component e) is now defined as being UVASORB HA88®. The basis upon which the Board held that claims 16-27 were not fully supported by the EP priority application was that the priority application failed to support the full scope of the definition of component e) of the claims in respect to the requirements of 35 USC §112. The Board did, however, recognize that the priority application did fully support the definition of component e) as UVASORB HA88® and that such definition did comply fully with the requirements of 35 USC §112, i.e., written description and enablement.

As to the fact that component e) in claims 30-41 is specified by trademark designation, note the discussion above regarding new claim 29.

It is also noted here that in the interference proceeding, the count was limited to a 1:1 weight ratio of the two components of the composition. New claims 30-41 (similarly to former claims 16-27) are not so limited. Nor should the claims be so limited.

Patentability of the subject matter here is based upon a synergistic relationship of the components of the stabilizer composition. That synergism was discussed at length and in detail in the prosecution of Applicant's parent application Serial No. 08/858,191, filed May 7, 1998, now U.S. Patent No. 6,015,849. A Declaration under 37 CFR 1.132 by the present inventor was presented and discussed. A copy of that Declaration, signed on April 6, 1998 is attached hereto for the convenience of the Examiner. As discussed in the prosecution of the parent application it is deemed that the data of this declaration establishes the requisite synergism for the full scope of the instantly claimed subject matter.

Also submitted herewith is a Declaration of Dr. Gugumus which established that the tested Component B of the prior Declaration was the commercially available UVASORB HA88® which is component e) of the new claims 30-41.

That the tested Component A of the Declaration corresponds to component a) of the claims is apparent from the structure for that component as set forth in the Declaration.

On the basis of the foregoing, Applicant respectfully submits that the newly submitted claims are allowable and that this application is in condition for allowance.

Respectfully submitted,

Shiela A. Loggins

Ciba Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-2768
SAL\20303.doc

Shiela A. Loggins
Agent for Applicants
Reg. No. 56,221

Enclosures: Declaration under 37 CFR 1.132, signed Nov. 4, 2008, copy of Declaration under 37 CFR 1.132, signed on April 6, 1998 and Amendment presenting added claim 28 during Interference No. 105,262.